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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/624,155 | 07/21/2003 | Jason S. Holland | 9008-44 | 7693 |
| 20792 | 7590 | 07/14/2004 | EXAMINER | |
| MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627 | | | PRUNNER, KATHLEEN J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3751 | |

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/624,155 | HOLLAND ET AL. |
| | Examiner Kathleen J. Prunner | Art Unit 3751 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 July 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 072103.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wuestman. Wuestman discloses a writing instrument (note Fig. 1) having all the claimed features including an elongated first barrel portion (constituted by barrel 10) that comprises an open first end (constituted by the lowermost end as shown in Fig. 1) through which a writing element is extended and an opposite open second end (note Fig. 3); a transparent, hollow second barrel portion (constituted by the transparent body section 11) that comprises an open third end (note the lowermost end as shown in Fig. 3) and an opposite fourth end (constituted by the uppermost end as shown in Fig. 3), and wherein the third end is secured within the second end of the first barrel portion 10 (note Figs. 3 and 7); a fluid (constituted by liquid 21) disposed within the hollow second barrel portion 11; and a plug 12 disposed within the third end, wherein the plug 12 prevents the fluid 21 from escaping from the hollow second barrel portion 11. With regard to claim 2, Wuestman further discloses that the third end has an annular rim, an internal surface and an external surface (note Figs. 3 and 4) wherein the plug 12 comprises a shank (constituted by coupling element 13) and a head portion (constituted by the enlarged end at 12 (note Fig. 3)) connected to the shank 13, wherein the head portion extends radially outward from the shank (note Fig. 3) to define a circumferential shoulder (note Fig. 3), wherein the shank 13 is disposed within the third end and the shoulder is in contacting relationship with the annular rim (note Fig. 3), and wherein the head portion tapers radially inward (note Fig. 3) such that the head portion does not contact an inside surface of the first barrel portion 10 second end (note Fig. 3) and such

that any degree of flexure of the first 10 and second 11 barrel portions relative to one another does not cause the head portion to contact the inside surface of the first barrel portion 10 second end especially since the screw threads would prevent this type of contact. With respect to claim 4, Wuestman also discloses that the third end is threadingly secured within the second end (note Figs. 3 and 7 and lines 29-37 in the second column on page 1). With respect to claim 6, Wuestman further discloses that the fluid 21 is translucent (note lines 19-21 in the first column on page 2) and further includes at least one object (constituted by the solid or granular or discrete material 18) disposed within the hollow second barrel portion 11, wherein the object 18 is configured to move through the translucent fluid 21 when the writing instrument is inverted (i.e., in the normal writing position) relative to horizontal and wherein movement of the object 18 is viewable through the transparent second barrel portion 11 (note from line 52 in the second column on page 1 to line 5 in the first column on page 2, and from lines 41-60 in the first column on page 2).

3. Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipic. Lipic discloses a writing instrument 1 having all the claimed features including an elongated first barrel portion (constituted by the end A) that comprises an open first end through which a writing element is extended and an opposite open second end (note Figs. 1 and 2); a transparent, hollow second barrel portion (constituted by shell 2) that comprises an open third end and an opposite fourth end (note Fig. 4), and wherein the third end is secured within the second end of the first barrel portion A (note Figs. 1 and 2); a fluid (constituted by liquid 6) disposed within the hollow second barrel portion 2; and a plug 3 disposed within the third end, wherein the plug 3 prevents the fluid from escaping from the hollow second barrel portion 2 (note lines 48-50 in the first column on page 1). With regard to claim 6, Lipic also discloses that the fluid 6 is translucent (note lines 8-11 in the first column on page 1) and further includes at least one object 5, 5a or 5b disposed within the hollow second barrel portion 2, wherein the object 5, 5a or 5b is configured to move through the translucent fluid 6 when the writing instrument is inverted (i.e., in the normal writing position) relative to horizontal and wherein movement of the object 5, 5a

or 5b is viewable through the transparent second barrel portion 2 (note lines 4-7 in the first column on page 1). With regard to claim 7, Lipic further discloses that the object 5, 5a or 5b is buoyant within the fluid 6 (note lines 48-49 in the second column on page 1). With respect to claim 8, Lipic additionally discloses that the 5, 5a or 5b comprises promotional indicia thereon (note Figs. 5-8, lines 12-19 in the first column on page 1 and lines 42-44 in the second column on page 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Tapner. Wuestman also discloses that the third end (i.e., the lower end of barrel portion 11 as shown in Fig. 3) is engaged to and secured in the upper end of the barrel portion 10 (note lines 29-34 in the second column on page 1) and that the parts of the writing instrument are formed of polymeric or plastic material (note lines 24-29 in the second column on page 1). Although Wuestman fails to disclose that the third end is adhesively secured, as called for by claim 3, or is welded, as called for by claim 5, attention is directed to Tapner who discloses another writing instrument having two barrel portions 10 and 11 which are either adhesively or cemented together or are welded together in order to provide a liquid-tight joint between the sections (note lines 11-23 in the second column on page 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to adhesively or cementingly secure or weld together the barrel portions of Wuestman in view of the teachings of Tapner in order to provide a liquid-tight joint between the sections so that there is no possibility of leakage.

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6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Yeh. Although Wuestman fails to disclose that the fluid 21 contains a second fluid which is insoluble in the first fluid, attention is directed to Yeh who discloses another writing instrument having a transparent barrel body portion 2 containing a fluid constituted by one solvent 4 and a second solvent 41 which are insoluble in each other (note lines 10-13 in col. 1) in order to form various irregular patterns so as to achieve a visually entertaining effect (note lines 27-31 in col. 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to form the fluid 21 of Wuestman from two fluids that are insoluble in each other in view of the teachings of Yeh in order to form various irregular patterns so as to achieve a visually entertaining effect.

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker. Although Wuestman fails to disclose that the writing instrument includes a light configured to illuminate the fluid, attention is directed to Ducker who discloses another writing instrument having a light 30 configured to illuminate the image or indicia appearing on the upper portion of the barrel (note lines 36-38 in col. 1 and lines 21-25 in col. 2) in order to enhance its appearance for advertising purposes (note lines 5-17 in col. 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to provide the writing instrument of Wuestman with a light in view of the teachings of Ducker in order to illuminate the image or indicia appearing in the upper portion of the barrel and to enhance its appearance for advertising purposes. With respect to claim 12, Ducker further teaches the obviousness of using a power source constituted by battery 24 and a switch 30 in communication with the light 30 and power source 24 wherein the switch is responsive to user activation for switching the light on and off (note lines 30-60 in col. 4).

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang. Although Wuestman fails to disclose that the writing instrument includes a light configured to illuminate the fluid, attention is directed to Wang who discloses another writing instrument having a light 313 configured to illuminate the image or indicia appearing on

the transparent surface of the barrel (note lines 7-11 and 49-51 in col. 1 and lines 35-36 in col. 2) in order to enhance its advertising purpose (note lines 64-67 in col. 2). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to provide the writing instrument of Wuestman with a light in view of the teachings of Wang in order to illuminate the image or indicia and the transparent surface appearing in the transparent portion of the barrel so as to enhance its advertising effect. With respect to claim 11, Wang also teaches the obviousness of disposing the light within the first barrel portion of the writing instrument (note Fig. 4). With regard to claim 12, Wang further teaches the obviousness of using a power source constituted by battery 315 and a switch 312 in communication with the light 313 and power source 315 wherein the switch is responsive to user activation for switching the light on and off (note lines 51-57 in col. 2).

9. Claims 13, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker for the same reasons noted above in paragraphs 2 and 7 supra.

10. Claims 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipic in view of Ducker for the same reasons noted above in paragraphs 3 and 7 supra.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker as applied to claims 13, 14 and 19 above, and further in view of Yeh for the same reasons noted above in paragraph 6 supra.

12. Claims 13, 18-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang for the same reasons noted above in paragraphs 2 and 8 supra.

13. Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang as applied to claims 13, 18-21 and 23 above, and further in view of Tapner for the same reasons noted above in paragraph 5 supra.

14. Claims 13, 15, 16, 20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipic in view of Wang for the same reasons noted above in paragraphs 3 and 8 supra.

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15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lipic in view of Wang as applied to claims 13, 15, 16, 20 and 23-25 above, and further in view of Yeh for the same reasons noted above in paragraph 6 supra.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuhn is cited to show a writing instrument having fluid disposed in a barrel portion with an object disposed within the fluid that is subject to the buoyancy of the liquid.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

July 8, 2004



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